



UNITED STATES
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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In re Application of	:	
John B. Harley et al	:	
Serial No.: 09/500,904	:	WITHDRAWAL OF ABANDONMENT
Filed: February 9, 2000	:	
Attorney Docket No.: OMRP 161 CIP	:	

This is in response to applicants' petition under 37 CFR 1.181, filed December 27, 2001, requesting revival of the above-identified application based on the filing of a proper and timely response.

BACKGROUND

A review of the file history shows the examiner mailed an Office action to applicants on December 28, 2000, setting a three month shortened statutory period for reply. Applicants filed a first reply to the Office action on July 5, 2001 (Certificate of Mailing dated June 28, 2001), with a three month extension of time request and fee. The reply included an amendment to the claims and specification. In a Notice of Non-compliant Amendment, mailed July 12, 2001, the Office stated that the amendments to the specification were not in proper form according to 37 CFR 1.121(b)(1)(ii) and (iii). Applicants indicated in the specification that Figures 9-11 were to be deleted, and apparently meaning the text portion of the specification referring to these figures was to be deleted also. However, this was not clearly stated. Applicants provided unnumbered clean copies of the affected pages of the specification incorporating the deletions. 37 CFR 1.121(b)(1)(ii) and (iii) require, respectively, a clean version of the paragraph of the specification which is to be amended and a marked up version of the paragraph showing the changes being made. In the instance where an entire paragraph is being deleted, direction to "cancel the paragraph at page xx, lines yy-zz" is sufficient. With respect to the paragraphs describing Figures 9-11, such direction would have been sufficient, but was not clearly stated in the amendment. Amendments to other paragraphs required presentation of a clean copy and marked up version showing the changes with directions to "replace the paragraph on page xx, line yy-zz with the amended paragraph". The portion of the amendment directed to the claims, however, was proper and was entered.

In reply to the letter of non-compliance, received August 10, 2001, applicants provided a new copy of the amendments to the specification which showed the numbered pages with the deleted portions bracketed and struck through for each page on which an amendment appeared. In addition, numbered clean copy pages were provided for all affected pages. However, the amendment was deemed to not fully (and rigidly) follow 37 CFR 1.121(b)(1) and a second Notice of Non-compliant Amendment was mailed to applicants on August 24, 2001. In neither instance was any explanation given applicants as to the nature of non-compliance other than to check the boxes on the preprinted form citing the rule and averring non-compliance. Applicants replied on December 7, 2001, by facsimile (original Certificate of Mailing dated October 24, 2001) (the original was subsequently received on January 8, 2002) with a request and fee for an extension of time providing again copies of the previously submitted amendments in the same form and a substitute specification. A Notice of Abandonment was mailed to applicants on December 19, 2001, indicating the case was being held abandoned since applicants had not filed a compliant amendment although offered several opportunities to do so. This petition to withdraw the abandonment was then filed on December 27, 2001.

DISCUSSION

It is clear that applicants attempted to comply with 37 CFR 1.121(b)(1), but failed to meet the letter of the rule. It is clear that applicants' amendment to the specification first submitted on June 28, 2001, were improper and not in compliance with the rule. However the amendment filed August 24, 2001, complied with the intent of the rule although the letter of the rule was not fully complied with. By submitting copies of existing pages with the portions to be deleted both bracketed and struck through applicants showed clearly the matter to be deleted as required by 37 CFR 1.121(b)(1)(iii). However, only those paragraphs actually being amended, not the entire page, should have been submitted and identified by page and line numbers. In addition, those paragraphs being deleted in their entirety need only have been referred to and not shown by bracketing and strike through. In order to comply with 37 CFR 1.121(b)(1)(ii) clean copies of the amended paragraphs, not entire pages, should have been submitted. However, since section (2) of the rule also refers to replacement of "sections" of the specification, and a page or consecutive pages of the specification can be considered a "section" of the specification applicants' submission of a full page clean copy of the specification with the changes incorporated therein is considered to meet this portion of the rule. The submission of a substitute specification, while unnecessary in this instance, would also have been considered to comply with the rule if it had been accompanied by a statement stating that no new matter had been added.

In view of applicants' efforts to comply with 37 CFR 1.121 in multiple ways, the Notice of Abandonment is hereby withdrawn and the application restored to pending status with the mailing of this decision.

Applicants' petition is **GRANTED**.

The application will be forwarded for proper entry of the amendments submitted, but not the substitute specification.

The application will then be forwarded to the examiner for further consideration not inconsistent with this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.

A handwritten signature in black ink, appearing to read "Bruce M. Kisliuk", written in a cursive style.

Bruce M. Kisliuk
Director, Technology Center 1600